

## **Remarks**

### **I. Status of claims**

Claims 1-30 are pending.

### **II. Claim rejections**

The Examiner has rejected claims 1-30 under 35 U.S.C. § 102(b) over Stefik (U.S. 5,629,980).

For the purpose of the following discussion, the Examiner is reminded that “for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly” (MPEP § 706.02(a)).

#### **A. Claims 1-11 and 21-27**

Claim 1 is an independent claim and claims 2-11 and 21-30 depend from claim 1.

##### **1. Independent claim 1**

Claim recites that the controller is configured to authorize wireless transmission of a transfer file to a third party device in accordance with meta-data associated with the particular digital content and without regard to any identifier of the third party device, wherein the transfer file includes meta data containing permissions information restricting rendering of the particular digital content by the third party device.

The Examiner has asserted that:

Stefik discloses a portable media device, comprising a memory configured to store digital content; a wireless transceiver configured to wirelessly transmit and receive digital content; an output configured to render digital content; and a controller coupled to the memory, the wireless transceiver and the output, the controller being configured to authorize wireless transmission of a transfer file to a third-party device based upon meta-data associated with a particular digital content, the transfer file including meta-data containing permissions

information controlling rendering of the particular digital content by the third party device (col 3 ln 50 – col 4 ln 36).

The Examiner, however, erroneously failed to address the feature recited in claim 1 wherein the controller is configured to authorize wireless transmission of a transfer file to a third party device without regard to any identifier of the third party device. By this omission, the Examiner has failed to establish a proper *prima facie* case of anticipation under 35 U.S.C. § 102(b). For at least this reason, the Examiner's rejection of independent claim 1 should be withdrawn.

In addition, Stefik fails to teach or suggest anything about a controller that is configured to authorize wireless transmission of a transfer file to a third party device without regard to any identifier of the third party device. In fact, Stefik teaches away from such a controller by requiring all repositories to be configured such that "repositories will only communicate with other devices that are able to present proof that they are certified repositories" (col. 13, lines 15-17), where such proof consists of possession of a digital identification certificate (see, e.g., col. 7, lines 57-65; see also, col. 8, lines 5-7: "identification certificates are the means by which a repository is identified as 'trustworthy'"). In particular, a registration transaction is performed for each usage transaction involving more than one repository (see col. 27, lines 30-34). "The goal of the registration transaction is to establish a secure channel between two repositories who know each other's identities" (col. 27, lines 36-38). During a registration transaction, each repository transmits a registration message that includes a respective identification certificate corresponding to the transmitting repository (see col. 27, lines 51-54).

For at least this additional reason, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 102(b) over Stefik should be withdrawn.

## 2. Claims 2-11 and 21-30

Each of claims 2-11 and 21-30 incorporates the features of independent claim 1 and therefore is patentable for at least the same reasons explained above. Claims 4, 6-10, and 21-24 also are patentable for the following additional reasons.

a. Claim 4

Claim 4 recites that the controller is configured to confirm a user license based upon a comparison of a user identifier embedded in the meta-data associated with a given digital content with a user identifier stored in the memory. Stefik's system does not confirm a user license based upon such a comparison. To the contrary, in Stefik's approach, a repository is granted access to a digital work based on whether or not the usage rights associated with the digital work grant such access (see, e.g., col. 4, lines 13-23). If such usage rights are found, access to the digital work is provided – no comparison of user identifiers is performed by Stefik's system to confirm a user license.

The Examiner has cited col. 11, lines 33-45, of Stefik's disclosure to support her rejection of claim 4. The totality of the cited disclosure is as follows:

It is fundamental to the present invention that the usage rights are treated as part of the digital work. As the digital work is distributed, the scope of the granted usage rights will remain the same or may be narrowed. For example, when a digital work is transferred from a document server to a repository, the usage rights may include the right to loan a copy for a predetermined period of time (called the original rights). When the repository loans out a copy of the digital work, the usage rights in the loaner copy (called the next set of rights) could be set to prohibit any further rights to loan out the copy. The basic idea is that one cannot grant more rights than they have.

Nowhere in this disclosure is there an explicit or inherent teaching or suggestion of a controller that is configured to confirm a user license based upon a comparison of a user identifier embedded in the meta-data associated with a given digital content with a user identifier stored in the memory of a portable media device.

b. Claim 6

Claim 6 also recites that the controller is configured to enable playback of only a sample of the digital content in response to a failed user license confirmation. Stefik does not expressly or impliedly teach such a feature. Stefik allows a creator to specify usage rights that allow a user to play a demo version of a digital work for free (see, e.g., col. 46, lines 43-

61), but Stefik does not even hint that a controller would be configured to enable playback of only a sample in response to a failed user license confirmation.

The Examiner has cited col. 30, lines 55-60, of Stefik's disclosure to support her rejection of claim 6. The totality of the cited disclosure is as follows:

Transactions can refer to a part of a digital work, a complete digital work, or a Digital work containing other digital works. Although not described in detail herein, a transaction may even refer to a folder comprised of a plurality of digital works. The term "work" is used to refer to whatever portion or set of digital works is being accessed.

Nowhere in this disclosure is there an explicit or inherent teaching or suggestion of a controller that is configured to enable playback of only a sample of the digital content in response to a failed user license confirmation.

c. Claim 7

Claim 7 recites that the controller is configured to direct received digital content selectively to unrestricted memory storage or to restricted memory storage based upon a user license confirmation. Stefik does not expressly or impliedly teach such a feature. Indeed, in Stefik's approach, all digital content is stored in the same content storage location 1204 (see FIG. 12), regardless of whether a user license is confirmed or not.

The Examiner has cited col. 30, lines 55-60, of Stefik's disclosure to support her rejection of claim 7. The totality of the cited disclosure is as follows:

Transactions can refer to a part of a digital work, a complete digital work, or a Digital work containing other digital works. Although not described in detail herein, a transaction may even refer to a folder comprised of a plurality of digital works. The term "work" is used to refer to whatever portion or set of digital works is being accessed.

Nowhere in this disclosure is there an explicit or inherent teaching or suggestion of a controller that is configured to direct received digital content selectively to unrestricted memory storage or to restricted memory storage based upon a user license confirmation.

d. Claim 8

Claim 8 incorporates the features of claim 7 and therefore is patentable for at least the same reasons. Claim 8 also recites that the controller is configured to direct licensed digital content to unrestricted memory storage and to direct unlicensed digital content to restricted memory storage. Stefik does not expressly or impliedly teach such a feature. Indeed, in accordance with Stefik's approach, both licensed content and unlicensed digital content are handled in the same way.

The Examiner has cited col. 30, line 61 – col. 31, line 5, of Stefik's disclosure to support her rejection of claim 8. The totality of the cited disclosure is as follows:

Many of the steps here involve determining if certain conditions are satisfied. Recall that each usage right may have one or more conditions which must be satisfied before the right can be exercised. Digital works have parts and parts have parts. Different parts can have different rights and fees. Thus, it is necessary to verify that the requirements are met for ALL of the parts that are involved in a transaction. For brevity, when reference is made to checking whether the rights exist and conditions for exercising are satisfied, it is meant that all such checking takes place for each of the relevant parts of the work.

Nowhere in this disclosure is there an explicit or inherent teaching or suggestion of a controller that is configured to direct licensed digital content to unrestricted memory storage and to direct unlicensed digital content to restricted memory storage.

e. Claim 9

Claim 9 incorporates the features of claim 7 and therefore is patentable for at least the same reasons. Claim 9 also recites that the controller is configured to restrict storage of unlicensed digital works to a predetermined quantity. Stefik does not even hint that a controller of a portable media device could be configured to restrict storage of unlicensed digital works to a predetermined quantity. Indeed, Stefik does not teach or suggest anything about restricting the quantity of digital works (whether licensed or unlicensed) that can be stored in a repository.

The Examiner has cited col. 30, line 61 – col. 31, line 5, of Stefik's disclosure to support her rejection of claim 9. The totality of the cited disclosure is as follows:

Many of the steps here involve determining if certain conditions are satisfied. Recall that each usage right may have one or more conditions which must be satisfied before the right can be exercised. Digital works have parts and parts have parts. Different parts can have different rights and fees. Thus, it is necessary to verify that the requirements are met for ALL of the parts that are involved in a transaction. For brevity, when reference is made to checking whether the rights exist and conditions for exercising are satisfied, it is meant that all such checking takes place for each of the relevant parts of the work.

Nowhere in this disclosure is there an explicit or inherent teaching or suggestion of a controller that is configured to restrict storage of unlicensed digital works to a predetermined quantity.

f. Claim 10

Claim 10 incorporates the features of claim 7 and therefore is patentable for at least the same reasons explained above.

g. Claim 21

Claim 21 recites that the controller is configured to control wireless transmission and rendering of a particular digital content based upon a comparison of a user identifier embedded in meta-data associated with the particular digital content with a user identifier stored in the memory. As explained above, Stefik's system does not confirm a user license based upon such a comparison. To the contrary, in Stefik's approach, a repository is granted access to a digital work based on whether or not the usage rights associated with the digital work grant such access (see, e.g., col. 4, lines 13-23). If such usage rights are found, access to the digital work is provided – no comparison of user identifiers is performed by Stefik's system to confirm a user license.

The Examiner has cited col. 31, lines 5-37, of Stefik's disclosure to support her rejection of claim 21. The totality of the cited disclosure is as follows:

FIG. 18 illustrates the initial common opening and closing steps for a transaction. At this point it is assumed that registration has occurred and that a "trusted" session is in place. General tests are tests on usage rights associated with the folder containing

the work or some containing folder higher in the file system hierarchy. These tests correspond to requirements imposed on the work as a consequence of its being on the particular repository, as opposed to being attached to the work itself. Referring to FIG. 18, prior to initiating a usage transaction, the requester performs any general tests that are required before the right associated with the transaction can be exercised, step, 1801. For example, install, uninstall and delete rights may be implemented to require that a requester have an authorization certificate before the right can be exercised. Another example is the requirement that a digital ticket be present and punched before a digital work may be copied to a requester. If any of the general tests fail, the transaction is not initiated, step, 1802. Assuming that such required tests are passed, upon receiving the usage request, the server generates a transaction identifier that is used in records or reports of the transaction, step 1803. The server then checks whether the digital work has been granted the right corresponding to the requested transaction, step 1804. If the digital work has not been granted the right corresponding to the request, the transaction terminates, step 1805. If the digital work has been granted the requested right, the server then determines if the various conditions for exercising the right are satisfied. Time based conditions are examined, step 1806. These conditions are checked by examining the time specification for the version of the right. If any of the conditions are not satisfied, the transaction terminates per step 1805.

Nowhere in this disclosure is there an explicit or inherent teaching or suggestion of a controller that is configured to control wireless transmission and rendering of a particular digital content based upon a comparison of a user identifier embedded in meta-data associated with the particular digital content with a user identifier stored in the memory of a portable media device.

h. Claims 22-24

Claims 22-24 incorporate that features of claim 21 and therefore are patentable for at least the same reasons.

i. Conclusion

For at least these additional reasons, the Examiner's rejection of dependent claims 4, 6-10, and 21-24 under 35 U.S.C. § 102(b) over Schneck should be withdrawn.

B. Claims 12-20

Claim 12 is an independent claim and claims 13-20 depend from claim 12.

Independent claim 12 has been amended and now recites that each of the portable media devices includes features of the portable media device recited in independent claim 1, including a controller that is configured to authorize wireless transmission of a transfer file to a third party device without regard to any identifier of the third party device.

Claim 12, therefore, is patentable for at least the same reasons explained above in connection with independent claim 1, and the Examiner's rejection of independent claim 12 under 35 U.S.C. § 102(b) over Stefik now should be withdrawn.

Each of claims 13-20 incorporates the features of independent claim 12 and therefore is patentable for at least the same reasons.

III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

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Respectfully submitted,

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